

REMARKS

The Applicant thanks the Examiner for his detailed comments. Amendments have been made to the abstract, specification, claims, and drawings. Claim 6 has been cancelled. Entry of the Amendments is respectfully requested.

Restriction Requirement

The Applicant disagrees and again traverses the Examiner's restriction requirement, since all of the claims as filed and pending in this application depend from one generic joint prosthesis claim, as recited in claim 1. Claim 7 has been amended to depend from claim 1. Claim 6 is cancelled.

MPEP 806.04(d) states that once a generic claim is allowed, all claims drawn to species in addition to the elected species will ordinarily be obviously allowable in view of the allowance of the generic claim since the additional species will depend thereon or otherwise include all of the limitations thereof.

Specification

In response to paragraph 3 in the examiner's detailed action, an updated cross-reference to related applications has been provided. A copy of the transaction history for the parent application which is attached and shows a preliminary amendment of July 17, 2002, which is apparently the date received by the USPTO. No new matter has been added. ✓

Brief Description of the Drawings

A brief description for figures 35-57 has been added by amendment in response to paragraph 3. No new matter has been added.

Replacement Drawings

In response to paragraph 4 of the Examiner's detailed action, a replacement sheet of drawings for Figures 38A through 38C has been provided. Figure 38C now describes an example of two arcuate curves J and K.

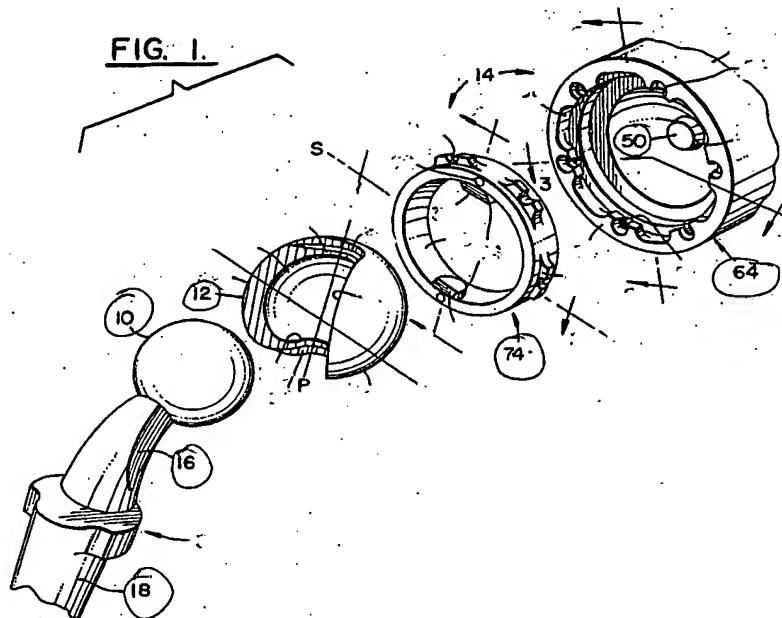
Formalities

With respect to the objection for informalities in paragraph 5, claims 1, 8 and 10 have been amended to incorporate the Examiner's comments. With respect to claim rejections under 35 U.S.C. §112, paragraph 2, the elements of the claims as amended are not indefinite.

Anticipation

With respect to the rejections under 35 U.S.C. §102 in paragraph 9, the amended claims are not anticipated by the cited reference. In order to anticipate a claim, a reference must disclose each and every element of a claim exactly. DeCarlo, US Patent No. 4,524,467, does not disclose a "segmented shell ... a second shell fixedly retained with ... said segmented shell [and] a cup ... being sized and configured to be fixedly retained in said second shell."

DeCarlo does not disclose a shell and a cup that is fixedly retained. Instead, DeCarlo discloses a socket bearing 12 that is pivotably retained by ring 74 in cup 14. See the figure below and column 5, lines 59-65 of DeCarlo. If the cup 14 is considered a segmented cup, then there is no shell, as that term is recited in claim 1. If socket bearing 12 is considered a cup, then the cup is not fixedly retained in the shell. Thus, DeCarlo fails to disclose each and every element of the claim exactly; therefore, claim 1 is not anticipated by DeCarlo.



Non-obviousness

In order to establish *prima facie* obviousness over the claims of the invention, a reference must teach or suggest every limitation of the invention. None of the cited references teach or suggest the limitations of the independent claims.

Claim 10 depends from claim 1 and incorporates all of the limitations of claim 1; therefore, Grimes fails to establish *prima facie* obviousness over claim 10. Specifically, Grimes fails to teach or suggest a cup “being sized and configured to be fixedly retained in said second shell” As previously mentioned, Grimes instead teaches a pivotably mounted socket bearing 12. Furthermore, Grimes fails to teach or suggest a segmented shell, as that term is claimed in claim 1. Accordingly, Grimes fails to establish *prima facie* obviousness over claim 10.

Claim 11 depends from claim 10 incorporating all of the limitations of claim 10 and additional limitations. Therefore, Grimes fails to establish *prima facie* obviousness over claim 11.

Claims 2 and 8 have been amended to place these claims in independent form. As the examiner indicated that these claims would be allowable if placed in independent form, claims 2 and 8 are now in condition for allowance.

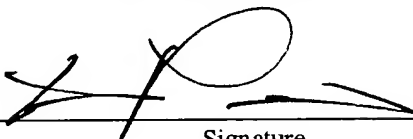
Accordingly, Hyde, Jr. as well as Grimes fail to establish *prima facie* obviousness over claims 10 and 11.

The amendments to the claims, specification, abstract and drawings now put the application in condition for allowance. The Applicant respectfully requests that the Examiner enter the amendments and indicate allowance of the claims that are now pending in this application.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 13, 2005

Christopher Paradies

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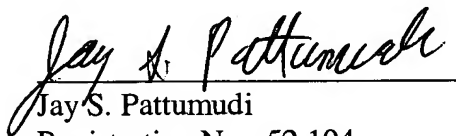
Signature

April 27, 2005

Date of Signature

JSP:kat
Enclosures

Respectfully submitted,



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06-24-2003	Non-Final Rejection
04-19-2003	Date Forwarded to Examiner
03-27-2003	Response to Election / Restrict
02-20-2003	Mail Notice of Informal or No
12-18-2002	Date Forwarded to Examiner
12-13-2002	Informal or Non-Responsive
12-13-2002	Response to Election / Restrict
11-26-2002	Mail Restriction Requirement
11-26-2002	Requirement for Restriction / E
07-17-2002	Preliminary Amendment
12-31-2001	Information Disclosure Stateme
01-03-2002	Case Docketed to Examiner i
09-24-2001	Information Disclosure Stateme
12-13-2001	Case Docketed to Examiner i
11-07-2001	Application Dispatched from OI
11-05-2001	Correspondence Address Ch
10-02-2001	IFW Scan & PACR Auto Secur
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